

REMARKS

The application has been reviewed in light of the Office Action mailed on August 15, 2006. Applicant's representatives thank Examiner Saether for the courtesy extended during the personal interview conducted on February 15, 2007. Reconsideration is respectfully requested for the following reasons.

The claims stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite. In particular, the Office Action asserts that "[i]n light of applicant's remarks, it is unclear what is the structure intended by the claimed 'knurled portion,' 'flute,' 'circumferential lip' and 'transition section.'" Applicant respectfully disagrees.

In the Amendment filed on September 21, 2005, Applicant discussed the claimed "knurled portion" with reference to the embodiments disclosed in paragraph [0034] of the specification. Applicant also stated (at p. 8) that a reference having "an anchoring section 6 with five ring-like projections 7, with the projections 5, 7 being coaxial and spaced apart from one another ... is not a 'knurled portion' and does not have intersection troughs." Moreover, the claims have been amended to recite that the "knurled portion" comprises "peaks and intersecting troughs." Thus, the term "knurled portion" is not unclear.

In the Amendment filed on September 21, 2005, Applicant stated (at p. 8) that "[a]s discussed in paragraph [0036] of the specification, for example, the 'flute 24 is essentially a channel of a groove. ... Element 8 the Fluckinger is not a 'flute,' but rather a notch provided in each of the spaced apart ring like projections 7." Moreover, the specification discloses that the "flute 24 runs through the knurled portion and generally has a length sufficient to extend the flute from one end of the knurled portion 18 to the other." The claimed invention is not limited to the disclosed embodiments. Thus, the term "flute" is not unclear.

Regarding the term "circumferential lip," in the Amendment filed on May 8, 2006, Applicant stated(at p. 8) that "[a]n exemplary embodiment of this feature is shown as element 34 in Figure 3 of the disclosure. The specification, for example, discloses that the circumferential lip 'extends about the circumference of the underside, or lower surface of the head 6. The circumferential lip 34 provides a surface for improved clamping of the cement board to a base material.' ... The claimed invention is not limited to the disclosed embodiments." Thus, the term "circumferential lip" is not unclear.

Regarding the term "transition section," Applicant explained (on pp. 9-10) in the Amendment filed on May 8, 2006, that "there is no transition section between two elements if the first element extends along the entire length of the object and the second element extends along a portion of the first element." In other words, Applicant explained that there is no transition section between two elements that overlap. Thus, the term "transition section" is not unclear.

Claims 1, 3-8, 10, 11-15, 17 and 24-27 stand rejected under 35 U.S.C. 103 as being unpatentable over Searelle in view of Jones. Reconsideration is respectfully requested for the following reasons.

As discussed during the interview conducted on February 14, 2007, the rejection would be overcome by submission of an Applicant's affidavit pointing out why Searelle and Jones are not properly combinable. The arguments presented by Applicant on pages 11-18 of the Amendment filed on May 8, 2006, regarding the rejection are incorporated by reference herein in their entirety.

Claims 12, 14 and 17 stand rejected under 35 U.S.C. 102(b) as being anticipated by Searelle, or alternatively as being unpatentable over Searelle in view of Lieggi. Reconsideration is respectfully requested.

Claim 12 recites a screw comprising a “shank having a tip at one end and a head at the other end, said head having a lower surface,” and that the “lower surface of said head further comprises a circumferential lip.” Claim 12 has been amended to recite “a continuous circumferential lip extending about a circumference of said lower surface” of the head. An exemplary embodiment of this feature is shown as element 34 in Figure 3 of the disclosure. The specification, for example, discloses that the circumferential lip “extends about the circumference of the underside, or lower surface of the head 6. The circumferential lip 34 provides a surface for improved clamping of the cement board to a base material.” Specification, paragraph [0039]. The claimed invention is not limited to the disclosed embodiments.

Searelle fails to teach or suggest this limitation, and claim 12 is allowable over Searelle for at least this reason. Claims 14 and 17 depend from claim 12 and are allowable for at least the same reasons as for allowance of claim 12, and for other reasons. For example, claim 17 recites the “screw of claim 12 further comprising a transition section disposed between said thread and said at least one flute.” Searelle clearly fails to teach or suggest this limitation, as discussed on pages 9-10 of the Amendment filed on May 9, 2006. This is an additional reasons for allowance of claim 17.

Further, the Office Action admits that Searelle “does not disclose the lip to be an uninterrupted circumferential lip,” and for this shortcoming relies on Lieggi. Lieggi discloses a drywall screw with an annular flange 26 on a flat head 20. Lieggi’s drywall

screw functions by having the flat head 20 seat flush with the drywall without damaging the outer surface of the drywall. Column 2, lines 48-65.

The Office Action asserts that it would have obvious to "provide the head of Searelle with [the annular flange 26 of] Lieggi because the lip provides an improved finish to the top surface and disclosed therein." Office Action, page 3. The proposed combination would serve no practical purpose and would make the Searelle screw unfit for its intended purpose.

There is no reason to add Lieggi's annular flange to the Searelle screw. Lieggi's annular flange is designed for drywall applications, and functions to seat flush and not to damage the outer surface of the drywall. The Searelle screw is a wood screw that "bores its own hole and countersinks its own head." The Searelle screw "seat[s] itself flush with the surface of the wood" (page 1, lines 9-12 and 69-70), so there is no reason to add, as the Office Action suggests, a "lip [to] provide[] an improved finish to the surface." There is no practical reason, let alone motivation, to make the proposed combination. The only reason for the proposed combination is to somehow account for the limitations recited in Applicant's invention.

Moreover, the Searelle screw has, on the underside of its head, a structure to prevent rotation of the screw when seated. The Searelle screw has grooves 4 which extend to the underside of its head and "terminate bluntly ... in order to stop the screw from being driven further after it is properly seated." Page 1, lines 52-55. Adding Lieggi's annular flange to Searelle's screw would add another, different mechanism to stop rotation of the Searelle screw. This would prevent Searelle's existent mechanism, which functions to stop rotations when properly seated, from performing as intended in Searelle.

For at least these reasons, Searelle and Lieggi are not properly combinable as proposed in the Office Action, and claim 12 and claims 14 and 17 dependent therefrom, are allowable. Claim 17 is also allowable for the additional reasons discussed above with respect to the rejection under Searelle.

Claims 2 and 15 stand rejected under 35 U.S.C. 103 as being unpatentable over Searelle in view of Jones or Searelle alone as applied to claims 1 and 12, and further in view of Koing, and claim 9 stands rejected under 35 U.S.C. 103 as being unpatentable over Fluckinger or Searelle in view of Jones as applied to claim 7 above, and further in view of Farrell. These rejections are respectfully traversed because they are based on improper rejections of base claims of dependent claims 2, 9 and 15. As discussed above, base claims 1, 7 and 12 are allowable, and claims 2, 9 and 15 dependent therefrom, respectively, are also allowable.

Moreover, the Applicants do not agree with the improper combinations proposed by the Office Action. For example, the Office Action asserts that the motivation to combine Koing with Searelle and Jones is to "provide an improved countersink means by improving the cutting action and chip as discussed in Koing." Office Action, page 4. Searelle already has specific and unique features on the head and neck of its screw such that the screw "bores its own hole and countersinks its own head." Page 1, lines 9-10. Thus, Searelle already has a fully functional "countersink means." Why would a skilled artisan further complicate Searelle's fully sufficient design, and further complicate the manufacturing process, to achieve nothing extra? The answer is that a skilled artisan would not make such a modification. The only reason for the proposed combination is to somehow come up with a combination of features to reject the Applicant's invention.

Claims 18, 19 and 21-23 stand rejected under 35 U.S.C. 103 as being unpatentable over Jones in view of Koing. Claim 18 was amended in a previous paper to recite a “knurled portion on said shank disposed between said thread and said head, and at least one flute in said knurled portion and extending onto at least a portion of said thread.” Jones and Koing, whether taken alone or in combination, fail to teach or suggest this claim limitation. For at least this reason, amended claim 18 is allowable. Claims 19 and 21-23 depend from claim 18 and should be allowed at least for the same reason, and for other reasons. The Office Action does not respond to the amendment and argument regarding claim 18. For this reason, Applicant submits that the finality of the Office Action should be withdrawn, and another Office Action should issue to address claim 18.

Claims 10 and 21 are alternatively rejected under 35 U.S.C. 103 as being unpatentable over Searelle in view of Jones and Jones in view of Koing as applied to claims 7 and 18, respectively, and further in view of Lieggi. This rejection is traversed. Claim 7 distinguishes over Searelle in view of Jones, and claim 18 is allowable over Jones in view of Koing, as discussed above. Lieggi adds nothing to remedy the deficiencies of the references with respect to claims 7 and 18, and, thus, dependent claims 10 and 21 are allowable for at least the same reasons their base claims are allowable.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Dated: February 15, 2007

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